

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GEOFFREY H. BAKER, RODERICK J. DORGAN,  
DAVID O. MORGAN, PETER R. SHELLEY and SIMON E. BLANCHFLOWER

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Appeal No. 95-0544  
Application No. 07/798,971<sup>1</sup>

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH and JOHN D. SMITH,  
Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 12 and 14 through 17, which are all of the claims remaining in the application.

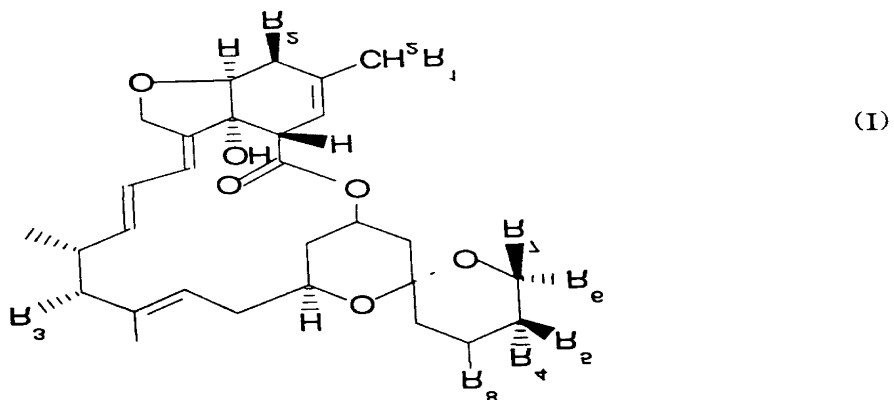
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<sup>1</sup> Application for patent filed November 29, 1991. According to appellants, this application is a continuation of Application No. 07/525,094, filed May 17, 1990, now abandoned.

Appeal No. 95-0544  
Application No. 07/798,971

Claim 12, which is illustrative of the subject matter on appeal, reads as follows:

12. A process for preparing a compound of formula (I)



wherein

R<sup>1</sup> is hydrogen or optionally protected hydroxy;

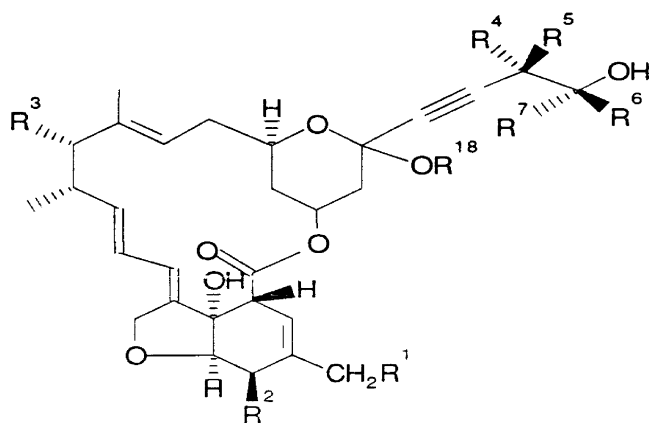
R<sup>2</sup> is alkoxy, optionally protected hydroxy, oxo, oximino, or oximino substituted by an organic radical;

R<sup>3</sup> is hydrogen, optionally protected hydroxy, or a group 4'-("L-oleandroxy)-"L-oleandroxyloxy or "L-oleandroxyloxy wherein the terminal hydroxy group is optionally protected;

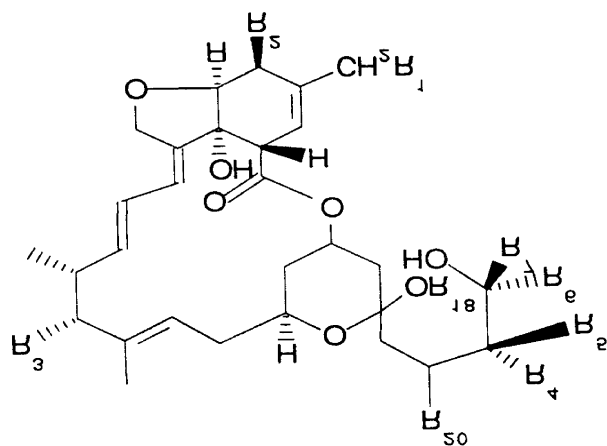
R<sup>4</sup>, R<sup>5</sup>, R<sup>6</sup>, and R<sup>7</sup> are the same or different and each is hydrogen or an organic radical; and

R<sup>8</sup> is amino, imino, amino substituted by an organic radical, imino substituted by an organic radical, optionally protected hydroxy, or oxo, the process comprising: (hydrating and) cyclizing a compound of formula (II), (IV), or (V)

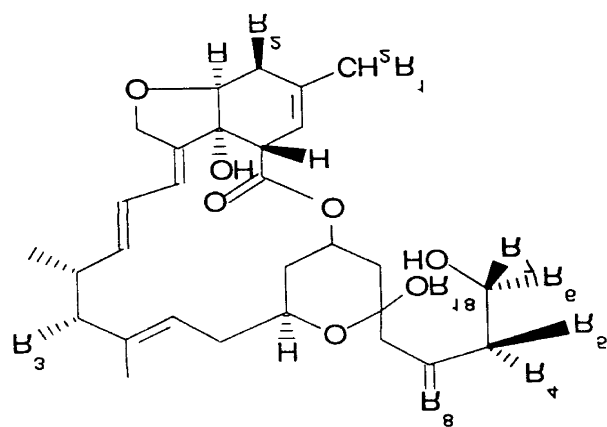
Appeal No. 95-0544  
 Application No. 07/798,971



(II)



(V)



(VI)

Appeal No. 95-0544  
Application No. 07/798,971

wherein

R<sup>18</sup> is hydrogen or lower alkyl, and R<sup>20</sup> is optionally protected ketone.

The single prior art reference relied on by the examiner is:

Smith, III et al. (Smith)	4,408,059	Oct. 4, 1983
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All of the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Smith and the acknowledged state of the prior art set forth in the specification, pages 18 and 20. All of the appealed claims further stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure in view of the recited terms "hydrating" and "cyclizing." Finally, claims 14 and 16 stand rejected under 35 U.S.C. § 112, second paragraph.

According to the examiner, the recitation of "acid/R<sup>18</sup> OH" in claim 14, step (b), is unclear. The examiner also argues that the recitation "R<sup>2</sup> and R<sup>4</sup> to R<sup>8</sup> inclusive are selected from among the values set forth in Table V of the specification" renders claim 16 indefinite "because it is improper for a

Appeal No. 95-0544  
Application No. 07/798,971

claim to be dependent from the specification" (Answer, page 3).

#### DISCUSSION

This is not a close case.

Having carefully reviewed the record, including appellants' "Second Brief on Appeal" (Paper No. 19) and the Examiner's Answer (Paper No. 20), we find that the rejections under 35 U.S.C. § 103 and 35 U.S.C. § 112, first and second paragraphs, do not rise to the level of superficial plausibility. These rejections are reversed for the reasons succinctly stated in the "Second Brief on Appeal."

In responding to the rejection of claim 16 under 35 U.S.C. § 112, second paragraph, appellants rely on Ex parte Moon, 224 USPQ 519 (Bd. App. 1984) (Second Brief on Appeal, pages 12 and 13). The examiner, however, does not even mention Ex parte Moon in the Answer. This illustrates the egregious nature of the examiner's prosecution in this application.

The examiner's decision is reversed.

REVERSED

Appeal No. 95-0544  
Application No. 07/798,971

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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WILLIAM F. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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JOHN D. SMITH	)	
Administrative Patent Judge	)	

Appeal No. 95-0544  
Application No. 07/798,971

Bradley N. Ruben  
Hopgood, Calimafde, Kalil,  
Blaustein & Judlowe  
60 East 42nd St.  
New York, NY 10165